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ART UNIT	PAPER NUMBER
2442	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/713,739	NAICK ET AL.
Office Action Summary	Examiner	Art Unit	
	Christopher Biagini	2442	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 October 2008</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3,4,8-10,12,13,15-18,20,23 and 33-35</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3,4,8-10,12,13,15-18,20,23 and 33-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to the rejection(s) under 35 USC 101 have been fully

considered and are persuasive. The rejection has been withdrawn.

Applicant's arguments with respect to the rejection(s) under 35 USC 103(a) have been

considered but are moot in view of the new ground(s) of rejection.

Specification

The specification is objected to as failing to provide proper antecedent basis for the

claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the

following is required: the specification must provide antecedent basis for generating, by the

server, emails in an order of generation based upon the groups of recipients, as claimed in claims

1, 10, and 18, and further limited in claims 33-35.

Claim Rejections - 35 USC § 112

Claims 1, 3, 4, 8-10, 12, 13, 15-18, 20, 23 and 33-35 rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

Claims 1, 10, and 18 recite the limitation "generating, by the email server, an

email…wherein generating the email and the one or more additional email comprises generating

the email…in an order of generation based upon the groups of recipients."

Paragraph [35] of the specification discusses ordering, but only in conjunction with the

user. The claims require that the server performs the ordering, but there is no explanation in the

specification for how the user interacts with the server to compose messages in order.

Claims 33-35 further recite: "wherein generating the email and the one or more additional

emails comprises generating the email comprising the email message with the instance and the

one or more additional emails in the order, wherein the order comprises composing a general

message for all recipients, thereafter composing a detailed message for a group of the recipients,

and thereafter composing specific messages for individual recipients that are part of the group of

the recipients."

Again, these features are only discussed with respect to user interactions. The claims

require that the server performs the ordering, but there is no explanation for how the server and

the user interact to compose the messages in order.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

Claims 1, 3, 4, 9, 10, 12, 15, 17, 18, 20, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Mansour (US Pub. No. 2002/0111995).

Regarding claim 1, Beyda shows a method for employing private content (recipient-specific comments: see col. 3, lines 3-7) in an email message for recipients, the method comprising:

- receiving, at an email server (message processor 20), the email message addressed to the recipients from an email client (see col. 2, lines 40-51 and col. 3, lines 28-32);

- identifying, by the email server, in response to receipt of the email message from the email client, an instance of the private content in the email message (see col. 3, lines 33-37);

- determining, by the email server, an association between the instance and at least one recipient (step 72: see col. 3, lines 46-53), wherein the email server does not determine associations between the instance and one or more remaining recipients of the recipients (note that Beyda provides for at least one recipient not being associated with the instance: see col. 3, lines 53-55);

- generating, by the email server, an email for the recipient based upon determining the association, the email comprising the email message with the instance (steps 76 and 78: see col. 3, lines 55-59);

- generating, by the email server, one or more additional emails for the one or more remaining recipients, wherein generating the one or more emails comprises redacting the email message to exclude the instance (step 74, comprising transmitting only the common portion: see col. 3, lines 53-55), wherein a redacted email message is created (comprising an email without comments), and generating the one or more additional emails with the redacted email message to display the email message with the instance when routed to the recipient (note that the message would display the instance since it is included in the message: see step 78) and to exclude the instance when routed to the one or more remaining recipients (see step 74); and

- transmitting, by the email server, the emails to the recipients (steps 74 and 78: see col. 3, lines 53-59).

Beyda further shows:

- identifying groups of recipients to receive the same or substantially similar email messages (comprising a group which receives a common message, and a group which receives a common message and comments: see col. 3, lines 8-18); and

- generating the email comprising the email message with the instance and the one or more additional emails in an order of generation based upon the groups of recipients (comprising first generating a common message which is sent to the group of all recipients and then generating comments for a group comprising a subset of all recipients: see col. 3, lines 8-18).

Beyda does not explicitly show:

- that the identifying and generating steps are performed at the server; and

- that associations are determined in response to identifying instances.

Mansour shows performing steps at a server based on input from a client (comprising application functionality: see [0008]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the performing of steps at a server as taught by Mansour in order to allow a user to interact with the system using an inexpensive, low-end device (see Mansour, [0008]).

Gilbert shows an email server determining associations between instances of content and recipients in response to identifying the instances (see col. 8, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the responsive determination of Gilbert in order to avoid wasting time determining associations when there are no instances of a particular kind of content in an email message.

Regarding claim 3, the combination further shows wherein identifying the instances comprises identifying a mark adjacent to the instance, wherein the mark is indicative of a bounding edge of the instance (see Gilbert, col. 4, lines 16-21 and col. 8, lines 1-16).

Regarding claim 4, the combination further shows wherein identifying the instance comprises identifying the instance as a highlighted portion of text in response to a command from a user (see Gilbert, col. 6, lines 38-47).

Regarding claim 9, the combination further shows wherein redacting the email message

to exclude the instance comprises deleting the instance from the email message (note that before

redacting, the comments are in the message of Beyda, and after redacting, the message contains

only the common content: see col. 3, lines 3-7 and 53-55).

Regarding claim 10, Beyda shows an apparatus (mail processor 20) for employing private

content in an email message for recipients, the apparatus being part of an email server (see col. 2,

lines 40-51) and comprising a computer processor and memory (implicitly provided by the

disclosure of an email server), the memory comprising computer instructions comprising:

- a content identifier to receive the email message from an email client (see col. 2, lines
  40-51 and col. 3, lines 28-32) and, in response, to identify one or more instances of
  private content in the email message (see col. 3, lines 33-37);

- a content associator to determine an association between at least one instance and a
  first set of one or more of the recipients (step 72: see col. 3, lines 46-53);

- an email generator to generate a first email for each recipient in the first set
  comprising at least one instance based upon an association with the at least one
  instance (steps 76 and 78: see col. 3, lines 55-59) and to redact the at least one
  instance from the email message to generate emails for additional sets of recipients
  (step 74, comprising transmitting only the common portion: see col. 3, lines 53-55), if
  any, to display the email message with the at least one instance when routed to the
  first set of one or more recipients (note that the message would display the instance

since it is included in the message: see step 78) and to exclude the at least one

instance when routed to other recipients (see step 74); and

- a messaging gateway coupled with the email generator to transmit the emails to the

  recipients (steps 74 and 78: see col. 3, lines 53-59).

Beyda further shows:

- a recipient selector to identify groups of recipients to receive the same or

  substantially similar email messages (comprising a group which receives a

  common message, and a group which receives a common message and

  comments: see col. 3, lines 8-18); and

- the email generator to generate emails in an order of generation based upon the

  groups of recipients (comprising first generating a common message which is

  sent to the group of all recipients and then generating comments for a group

  comprising a subset of all recipients: see col. 3, lines 8-18).

Beyda does not explicitly show:

- that the identifying and generating steps are performed at the server; and

- associating remaining instances, if any, with additional sets of recipients.

Mansour shows performing steps at a server based on input from a client (comprising

application functionality: see [0008]). It would have been obvious to one of ordinary skill in the

art at the time of the invention to modify the system of Beyda with the performing of steps at a

server as taught by Mansour in order to allow a user to interact with the system using an

inexpensive, low-end device (see Mansour, [0008]).

Gilbert shows associating multiple instances of content in an email with multiple sets of recipients (see Fig. 5 and col. 8, lines 8-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the multiple instances and additional sets of recipients taught by Gilbert in order to provide increased flexibility when composing messages to diverse groups.

Claim 12 corresponds to claim 3 and is rejected for the same reasons as given above.

Regarding claim 15, the combination further shows wherein the content associator is configured to generate an index associating the first set of the recipients with at least one location of one or more instances in the email message (see Gilbert, col. 5, lines 6-25).

Claim 17 corresponds to claim 9 and is rejected for the same reasons as given above.

Claims 18 and 20 correspond to claims 1 and 3 and are rejected for the same reasons as given above.

Regarding claim 33, the combination further shows wherein generating the email and the one or more additional emails comprises generating the email comprising the email message with the instance and the one or more additional emails in the order, wherein the order comprises composing a general message for all recipients (comprising a common message: see Beyda, col. 3, lines 8-10), thereafter composing a detailed message for a group of the recipients (comprising

the common message plus comments, which is sent to a group comprising a subset of all

recipients: see Beyda, col. 3, lines 14-18), and thereafter composing specific messages for

individual recipients that are part of the group of the recipients (see Beyda, col. 3, line 44 to col.

4, line 2, especially col. 4, line 66 to col. 4, line 2).

       The combination does not explicitly show wherein all the steps are performed at the

server.

       Mansour shows performing steps at a server based on input from a client (comprising

application functionality: see [0008]). It would have been obvious to one of ordinary skill in the

art at the time of the invention to modify the system of Beyda with the performing of steps at a

server as taught by Mansour in order to allow a user to interact with the system using an

inexpensive, low-end device (see Mansour, [0008]).

       Claims 34 and 35 correspond to claim 33 and are rejected for the same reasons as given

above.

       Claims 8, 16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Mansour

(US Pub. No. 2002/0111995) and Rafal (US Pub. No. 2002/0002586).

       The combination shows the limitations of claims 1, 10, and 18 as applied above, and

further shows displaying the instance in response to routing the email to the recipient

(necessarily the case, as the instance is included in the email: see Beyda, col. 1, lines 59-67).

The combination does not show using hypertext markup language code to display the instance.

Rafal shows using hypertext markup language code to display email content (see [0037]). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system of Beyda with the HTML code taught by Rafal in order to provide for text formatting in the email.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Mansour (US Pub. No. 2002/0111995) and Altavilla (US Pub. No. 2002/0194280).

The combination shows the limitations of claim 10 as applied above, but does not show wherein the content identifier is configured to parse a table, wherein the table identifies a location of the instance in the email message.

Altavilla shows parsing a table, wherein the table identifies a location of an instance of content in an email message (the table comprising a set of tags attached to recipients: see Fig. 3 and [0025]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system of Beyda to use a table as taught by Altavilla in order to associate recipients with appropriate instances of content without inserting markup into the email body.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on weekdays from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2442

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